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7590

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Helen C. Lockhart c/o Wolf, Greenfield & Sacks  
P.C./ Federal Reserve Plaza  
600 Atlantic Avenue  
Boston, MA 02210-2211

EXAMINER

LUDLOW, JAN M

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/783,472

Applicant(s)

CHAN ET AL.

Examiner

Jan M. Ludlow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5, 7, 13-14, 16-17, 19-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 14015, 17-18, 20-21 of copending Application No. 09/875779. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claim language is not identical, the limitations of the instant claims are encompassed by the claims of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear as a whole. While it is directed to a method of measuring velocity, the polymer is not even recited as moving. Further, while the claim specifies in line 9 that measurements are taken before and after the polymer is in said detection

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zone, the claim does not recite taking measurements while the polymer is in the detection zone, which is essential or critical to the invention (see, e.g., Figures 1 and 2). If measurements are taken before and after, but not during, is anything detected? In line 6, "the respective detection zone" lacks antecedence and is therefore unclear. In line 8, "said detection zone" is unclear—is the respective zone (line 6) or the different one of a plurality (line 3) or the plural zones (line 4) intended? In line 9, "the path" lacks antecedence—what path? See also claims 8 and 13. In claim 13, part c) line 3, should "and" be "or" between "first" and "second"? In claim 13, part d), what is the time interval multiplied by? Claim 20 lacks antecedence for "said... labels" because it depends from claim 13, in which no labels are recited.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 13, 14, 16, 17, 19, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilmanishin et al ('286).

Gilmanishin teaches a method of determining velocity and distance between labels in a DNA molecule by passing the molecule past fluorescence-modifying stations and measurement of fluorescence profiles (col. col. 14, lines 30-47).

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The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. Claims 8, 15, 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Tegenfeldt (WO/00/09757).

Tegenfeldt teaches passing an elongated polymer such as DNA or RNA past an optical detector station and an electrical interaction station. The profile collected in the second station is used to determine velocity and length. The optical station may detect fluorescence (p. 16, esp. lines 19-27).

7. Claims 1-2, 14, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Castro (WO 98/10097).

Castro teaches a method of determining velocity of DNA using fluorescent measurement at two detectors spaced apart in a flow path (p. 7, p. 13, Figure 4).

8. Claims 1-2, 14, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Castro et al (SPIE).

Castro teaches a method of determining velocity of DNA using fluorescent measurement at two detectors spaced apart in a flow path (Figures 2-3 and accompanying text).

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9. Claims 1-2, 14, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ekstrom et al (BioTechniques).

Ekstrom teaches a method of determining velocity of DNA using fluorescent measurement at two detectors spaced apart in a flow path (Figures 1-2 and accompanying text, e.g., p. 231, middle column).

10. Claims 3-7, 9-12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or suggest the specific methods involving the particular analysis of the detection profiles as claimed.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shortreed et al additionally teaches methods of measuring DNA velocity in electrophoresis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (703) 308-4039. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jan M. Ludlow  
Primary Examiner  
Art Unit 1743

jml  
June 24, 2003